

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s):	Robellard et al.)	Group Art Unit:	3781
)		
Serial No.:	10/758,626)	Examiner:	Stephen J. Castellano
Confirmation No.	6109)		
)		
Filed:	January 15, 2004)		
For:	<u>RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE</u>			

REPLY BRIEF

Commissioner for Patents
Mail Stop - Reply Brief - Patents
P.O. Box 1450
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Sir:

This Brief is presented in response to the Examiner's Answer of October 28, 2008 received in response to Appellant's Appeal Brief of August 11, 2008.

Appellants maintain the request that the Board reverse all of the final rejections of the pending claims as discussed in the Appellant's Appeal Brief of August 11, 2008.

Remarks

Re: Item A of the Examiner's Answer, pages 4-5 & 10-11

Claims 30, 32, 38, and 40 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Hanssen (U.S. Patent No. 3,825,970). *See Final Office Action*, February 13, 2008, page 2.

The Examiner describes in the Examiner's Answer that the inner surface 35 of the roller 34 of Hanssen could distribute liquid to a roller-type liquid applicator if the applicator were placed inside the roller 34 and further asserts that "[f]or this reason, the inner surface 35 is inherently capable of distributing liquid over a roller-type liquid applicator." *Examiner's Answer*, October 28, 2008, page 5 (emphasis added). As a result, it appears that the Examiner is basing this anticipation rejection on an allegedly inherent teaching of Hanssen.

The requirements for an anticipation rejection based on inherency, however, have not been met.

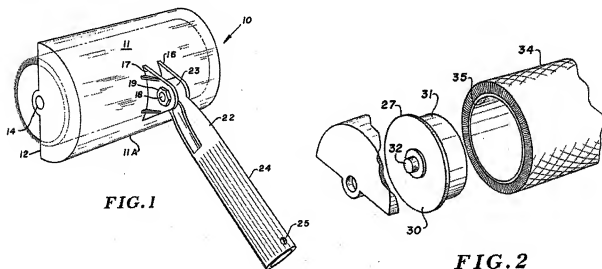
"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112(IV), 8th Edition, Rev. 6, September 2007 (emphasis in original, citations omitted). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at § 2112(IV), *citing In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Id.* at § 2112(IV), *citing Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner asserts the following:

A small roller of a width smaller than the inner circumference of surface 35 and shorter in length than the roller 34 [of Hanssen] would fit within the roller 34 with the roller end caps and the shield assembled. Paint within the roller inner cavity bound by the inner surface 35 and the end caps would be applied to the small roller through the rolling action of the roller 34 within its shield. With the assistance of gravity, the small roller placed inside roller 34 will roll to the lowest position inside roller 34 as roller 34 rotates transferring paint around the entire circumference of the small inner roller.

Examiner's Answer, October 28, 2008, page 5.

For convenience, Figures 1 and 2 of Hanssen are reproduced below.



Figures 1 & 2 of Hanssen

It thus appears that the Examiner is asserting that a certain result (i.e., paint may be transferred to the small roller) may occur from a given set of circumstances (i.e., when the small roller and a quantity of paint are placed inside the roller 34 and assisted by gravity). Appellants assert that this is insufficient to establish inherency.

For example, there is no basis in fact and/or technical reasoning to support that the allegedly inherent characteristic (i.e., that a small roller could be placed inside the roller 34 to distribute paint to the small roller) necessarily flows from the teachings of Hanssen. In fact, contrary to the Examiner's assertions, it is unclear how a "small roller" could even be placed inside the roller 34 and accessed with "the roller end caps and the shield assembled" (*see* Answer, page 5) nor is it clear how the "small roller" could then be removed without disassembling the apparatus 10 (e.g., removing the endcap 27 of Figure 2). It is further unclear how paint would flow into the inner space of the roller 34 as the inner cavity is sealed by the end caps. For at least these reasons, Appellants submit that the allegedly inherent characteristic of Hanssen has not been presented as necessarily flowing from the teachings of Hanssen as required for an anticipation rejection based on inherency.

For at least these reasons, Appellants maintain that Hanssen fails to anticipate claims 30, 32, 38, and 40.

Re: Item B of the Examiner's Answer, pages 6 & 11-12

Claims 30, 32, and 40 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Dumesnil, Jr. (U.S. Patent No. 4,107,815). *See Final Office Action*, February 13, 2008, page 3.

The Examiner asserts the following:

The outer surface of transfer roller 14 is inherently capable of distributing liquid over a roller-type liquid applicator when a roller applicator is positioned to contact the outer surface of the transfer roller 14 and a rolling motion is imparted to the transfer roller 14 such that the transfer roller moves within paint to transfer the paint from the paint tray to the transfer roller[.] Simultaneously, the roller applicator positioned in contact with the transfer roller 14 is moved in a rolling motion by the rolling motion of the transfer roller 14 and the paint on the transfer roller 14 is transferred to the roller applicator.

Examiner's Answer, October 28, 2008, page 6 (emphasis added).

Again, it appears that the Examiner is now basing this anticipation rejection on an allegedly inherent teaching of Dumesnil, Jr.

The requirements for an anticipation rejection based on inherency, however, have not been met (see requirements for inherency described above).

It appears that the Examiner is asserting that a certain result (i.e., paint may be transferred from the transfer roller 14 to the roller-type liquid applicator) may occur from a given set of circumstances (i.e., the transfer roller 14 could contact a roller-type liquid applicator and the transfer roller 14 could be rotated (presumably by an external force) and, simultaneously, the roller-type liquid applicator could be placed in contact with the transfer roller 14 to transfer paint and rotational movement to the roller-type liquid applicator).

However, this assertion is clearly insufficient to establish inherency. Appellants reiterate that the inherent characteristic being asserted (i.e., that paint may be transferred from the transfer roller 14 to the roller-type liquid applicator by rotating the transfer roller 14 and simultaneously contacting the transfer roller 14 and roller-type liquid applicator), has not been presented with a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Dumesnil, Jr. as required for an anticipation rejection based on inherency. For example, Dumesnil, Jr. teaches that the transfer roller is rotated (and thus paint is transferred to the pad) by the movement of the pad across the transfer roller (see *Abstract*). There is no explanation, however, of how such transfer would occur with two *free-rolling* cylindrical members as would be the case if the pad was replaced with a roller-type liquid applicator (e.g., it is unclear how differential rolling would be imparted in such a configuration).

For at least these reasons, Appellants maintain that Dumesnil, Jr. fails to anticipate claims 30, 32, and 40.

Re: Item C of the Examiner's Answer, page 7 & 12

Claims 33 and 38 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Dumesnil, Jr. in view of Bedrossian (U.S. Patent No. 5,314,061). See *Final Office Action*, February 13, 2008, page 4.

With respect to claim 33, the Examiner asserts in the Examiner's Answer that "[t]here is no indication from the claim language that the seal must extend around the entire circumference or be watertight." *Examiner's Answer*, October 28, 2008, page 7. The Examiner further asserts the following:

The type of seal is not specified to be watertight. The circumferential extent of the seal is not specified to be completely around the entire circumference of the open top. For this reasoning, the lid of Bedrossian applied to the open top of Dumesnil will tightly seal along three of the four sides and is operable to seal the open top.

Examiner's Answer, October 28, 2008, page 12.

Claim 33 recites "a selectively removable lid operable to seal the open top." Appellants submit any claim construction that interprets "a selectively removable lid operable to seal the open top" to be a lid that only seals along three of four sides of a container is clearly unreasonable.

With respect to claim 38, Appellants note that no new arguments are presented herein as it is believed that this rejection is satisfactorily addressed in the Appeal Brief.

For at least this reason, Appellants maintain that Dumesnil, Jr. in view of Bedrossian fails to obviate claims 33 and 38.

Re: Item D of the Examiner's Answer, pages 8 & 13

The Examiner notes the following:

No argument is presented under this heading. Appellant remarks mostly about Keller under the Item E heading and it is believed that appellant chooses to rebut this rejection under the heading for Item E.

Examiner's Answer, October 28, 2008, page 13.

Appellants clarify that arguments regarding the rejection of claims 1-7, 10, 12-16, 18, 26-27, 29, and 36-37 under 35 U.S.C. § 103(a) over Dumesnil, Jr. (U.S. Patent No. 4,107,815) in view of Bedrossian (U.S. Patent No. 5,314,061) and Keller (U.S. Patent App. Pub. No. 2003/0074760) and the rejection of claims 21-22 under 35 U.S.C. § 103(a) over Dumesnil, Jr. (U.S. Patent No. 4,107,815) in view of Bedrossian (U.S. Patent No. 5,314,061) and Keller (U.S. Patent App. Pub. No. 2003/0074760) as applied to claim 1, and further in view of Carling et al. (U.S. Patent No. 5,992,106) are combined and presented together. *See Appeal Brief*, August 11, 2008, pages 21-24. Further, with respect to this item, Appellants note that no additional arguments are presented herein as it is believed that these rejections are satisfactorily addressed in the Appeal Brief.

Re: Item E of the Examiner's Answer, pages 9 & 13

With respect this item, Appellants note that no additional arguments are presented herein as it is believed that this rejection is satisfactorily addressed in the Appeal Brief.

Re: Item F of Examiner's Answer, page 13

The Examiner notes the following:

No argument is presented under this heading. Appellant remarks pertaining to the obvious-type double patenting rejections seem to apply equally to both double patenting references.

Examiner's Answer, October 28, 2008, page 13

Appellants clarify that arguments regarding the rejection of claims 1-7, 10, 12-16, 18, 21-22, 26-27, 29-30, 32-33, 36-38, and 40 on the ground of non-statutory obviousness-type double patenting over the claim (i.e., the drawings) of U.S. Patent No. D524501 to Prokop et al. in view of Bedrossian (U.S. Patent No. 5,314,061) and the rejection of claims 1-7, 10, 12-16, 18, 21-22, 26-27, 29-30, 32-33, 36-38, and 40 on the ground of non-statutory obviousness-type double patenting over the claim (i.e., the drawings) of U.S. Patent No. D524003 to Prokop et al. in view of Bedrossian (U.S. Patent No. 5,314,061) are combined and presented together. *See Appeal Brief*, August 11, 2008, pages 25-27.

Re: Items F & G of Examiner's Answer, pages 9-10 & 14

Appellants maintain that two-way obviousness is required for design-utility rejections for at least the reasons recited in the Appeal Brief. The Examiner has not provided any authority that indicates one-way obviousness is the appropriate standard in design-utility cases, or that two-way obviousness is inappropriate.

Instead, the Examiner attempts to factually distinguish the present application from the cited cases (i.e., *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) and *Carman Indus., Inc. v. Wahl et al.*, 724 F.2d 932, 220 U.S.P.Q. 481 (Fed. Cir. 1983)) that support two-way obviousness tests in design-utility situations. See *Examiner's Answer*, October 28, 2008, page 14. Nothing is identified by the Examiner within such cases, however, that teaches that the use of two-way obviousness testing in design-utility situations is *fact specific* as asserted by the Examiner. Instead, such cases recite that the proper test for making design-utility double patenting rejections is two-way obviousness. In fact, as discussed in the Appeal Brief, the M.P.E.P. itself affirmatively recites that the proper test for making design-utility double patenting rejections is two-way obviousness as shown in the following excerpt:

Examiners should particularly note that a **design-design** nonstatutory double patenting rejection does not always have to be made in both of the conflicting applications. For the most part, these rejections will be made in each of the conflicting applications; but, if the rejection is only appropriate in one direction, it is proper to reject only one application. The criteria for determining whether a one-way obviousness determination is necessary or a two-way obviousness determination is necessary is set forth in MPEP § 804. **However, in design-utility situations, a two-way obviousness determination is necessary for the rejection to be proper.**

M.P.E.P. § 1504.06 (II), 8th Edition, Rev. 6, September 2007, citing *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), emphasis added).

For at least these reasons, Appellants maintain the claims 1-7, 10, 12-16, 18, 21-22, 26-27, 29-30, 32-33, 36-38, and 40 are not obvious over Prokop et al. '501 in view of Bedrossian or Prokop et al. '003 in view of Bedrossian.

Reply Brief

Serial No.: 10/758,626

Confirmation No.: 6109

Filed: January 15, 2004

For: RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE

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Re: (10) Response to Argument of the Examiner's Answer, page 10

The Examiner asserts in the Examiner's Answer that "appellant has admitted on the record that the amendment: 'first roller surface for distributing liquid over a roller-type liquid applicator' as added to claims 30 and 38 in the November 30, 2007 amendment doesn't narrow the claims" and that "Appellant stated that 'this amendment is not narrowing.'" *Examiner's Answer*, October 28, 2008, page 10.

For clarification of the record, the Amendment and Response of November 30, 2007 recited the following: "This amendment is intended to make explicit what was already implied, e.g., this amendment is not narrowing." *Amendment and Response*, November 30, 2007, page 8, emphasis added.

Summary

For the foregoing reasons, Appellants respectfully request that the Board review and reverse the final rejection of claims 1-7, 10, 12-16, 18, 21-22, 26-27, 29-30, 32-33, 36-38, and 40 as discussed herein, and that notification of the allowance of these claims be issued.

Respectfully submitted

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CERTIFICATE UNDER 37 CFR § 1.8:

The undersigned hereby certifies that this paper is being transmitted via the U.S. Patent and Trademark Office electronic filing system in accordance with 37 CFR § 1.6(a)(4) to the Patent and Trademark Office addressed to the Commissioner for Patents, Mail Stop Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of December, 2008.

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